

Remarks

Claims 14-54 are pending in the subject application. By this Amendment, Applicants have canceled claims 14-54 and added new claims 55-93. Applicants have also amended the specification in order to properly identify trademarks and correct inadvertent typographical errors. Support for the new claims can be found throughout the subject specification and in the claims as originally filed (see, for example, paragraphs 12, 18, 214, and 610-623 of United States Patent Application Publication No. 2003/0027161). For the purposes of this response, any reference to paragraph numbers relates to the numbered paragraphs of United States Patent Application Publication No. 2003/0027161. Claims 55-76 read on the elected invention and are under examination; claims 77-93 stand withdrawn from consideration as being drawn to non-elected inventions. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 55-93 are currently before the Examiner and favorable consideration of the pending claims is respectfully requested.

As an initial matter, Applicants acknowledge the Examiner's indication that claim 29 was inadvertently listed in Group III of the Restriction Requirement and that claim 29 should have been listed in Group I. Accordingly, claims 30-40 have been examined.

Applicants also acknowledge that the Patent Office may, where appropriate, require applicant, under 35 U.S.C. § 121, to elect claims to either the product or process and that claims directed to the non-elected invention are withdrawn from further consideration under 37 C.F.R. § 1.142. However, Patent Office policy related to the treatment of product and process claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b) indicates that if applicant elects claims directed to the product and the product is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product will be rejoined.

With respect to this policy, Applicants respectfully submit that claims 77-93 relate to withdrawn process claims that include all the limitations of, or depend from, the product claims under examination in this matter. Should the product claims currently under examination in this matter be found allowable by the Patent Office, Applicants respectfully request that the Patent Office rejoin claims 77-93 and that these claims be allowed as well.

The Examiner has indicated that the title of the invention is not descriptive and that a new title is required that is clearly indicative of the invention to which the claims are directed. Applicants have amended the title of the invention to "Serine Carboxypeptidase hx (SCPhx) and Compositions Thereof" which more clearly indicates the claims to which the invention is directed. Accordingly, reconsideration and withdrawal of this objection is respectfully requested.

Attached with this Amendment is a replacement sequence listing for inclusion in the subject application. This sequence listing has been provided to bring the subject application in compliance with the Sequence Rules. A Submission of Sequence Listing and Statement Under §1.821, including a replacement sequence listing on CD-ROM and a computer readable format is attached. In addition, Applicants have amended the subject specification to designate each sequence by a SEQ ID NO. after the disclosure of the sequences. Applicants respectfully submit that no new matter is added by this amendment of the specification. Entry of the replacement sequence listing is respectfully requested.

Claims 30-40 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. By this Amendment, Applicants have canceled these claims thereby rendering this rejection moot. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 34, 35, 38, and 39 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The rejection of the claims is moot in view of their cancellation. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Claims 31-39 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Again, as these claims have been canceled, it is respectfully submitted that this issue is now moot. However, Applicants provide the following information in order to address this issue as it may apply to the newly presented claims.

At the outset, Applicants respectfully submit that the claims as filed are definite. As is set forth at paragraph 45 of the published application:

In the case of secreted proteins, it should be noted that, in accordance with the regulations governing Sequence Listings, in the appended Sequence Listing the encoded protein (i.e. the protein containing the signal peptide and the mature protein or fragment thereof) extends from an amino acid residue having a negative number through a positively numbered amino acid residue. Thus, the first amino acid of the mature protein resulting from cleavage of the signal peptide is designated as amino acid number 1, and the first amino acid of the signal peptide is designated with the appropriate negative number.

Applicants respectfully assert that the correct position of the signal sequence is given under section <400> on which the signal sequence corresponds to amino acids -26 to -1 and that the mature protein corresponds to amino acids 1 to 267. The issue noted by the Examiner in section <222> of SEQ ID NO: 4 is an inadvertent error that arose in the preparation of the sequence listing in this matter and the error has been corrected in the substitute sequence listing that has been submitted with this response. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claims 31, 34, 35, 37, and 40 are rejected under 35 U.S.C. § 102(b) as anticipated by Dumas *et al.* (WO 99/53051). As noted above, claims 31, 34, 35, 37 and 40 have been canceled thereby rendering the rejection of those claims moot. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachments: Submission of Sequence Listing and Statement Under §1.821
One copy of Sequence Listing on CD for Computer Readable Format
Two copies of Sequence Listing on CDs (Labeled "Copy 1" and "Copy 2")